UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
HAYES, JOHN W

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 November 2002</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-7,9,10,13,25,27-29 and 31-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-7,9,10,13,25,27-29 and 31-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 December 1999* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR

1.17(e), was filed in this application after final rejection. Since this application is eligible for continued

examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the

finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's

submission filed on 29 November 2004 has been entered.

Status of Claims

2. Applicant has amended claims 1-2, 4-5, 7, 9-10, 13, 25, 27-29 and 31-32 and added new claims 35-

41 in the amendment filed 29 November 2004. Applicant has previously canceled claims 3, 8, 11-12 and

14-24, 26 and 30. Thus, claims 1-2, 4-7, 9-10, 13, 25, 27-29 and 31-41 remain pending and are

presented for examination.

Response to Arguments

3. Applicant's arguments filed 02 February 2004 have been fully considered but are not persuasive.

Applicant disagrees that the first trial license taught by Rose is equivalent to the install license

recited in the claims and further asserted that Rose fails to disclose generating an install license for

software installed on the local computer. Examiner first submits that the reference to Rose was not relied

upon to teach generating an install license for software installed on the local computer, but rather, the

reference to Gradient was relied upon for this teaching. In response to applicant's arguments against the

references individually, one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871

(CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore,

examiner

Applicant further argues that examiner has admitted that the function of the install license is

different than the function of the trial license. Contrary to applicants argument, examiner did not make

such an admission. Examiner stated that Misra et al further fail to specifically disclose that the install

license is being replaced by a trial license and further stated that the first trial license disclosed by Rose is

equivalent to the install license recited in the claims since applicant discloses in the specification that the

"install" license is always set to expire immediately and only used to initiate the generation of a trial

license (see applicant's specification, page 6, lines 19-25 and page 13, lines 6-13). Thus, the install

license recited in the claims is essentially equivalent to a "trial license", such as that taught by Rose since

the install license is only temporary and does not provide unlimited use of the software.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections

set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-2, 4-7, 9-10, 13, 25, 27-29 and 31-38 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Misra et al, U.S. Patent No. 6,189,146 B1 in view of Gradient, "Gradient Introduces

End User Software License Creation and Delivery Tool For Its iFOR/LS Licensing Technology, dated 21

March 1994 and Rose, U.S. Patent No. 5,708,709.

As per **Claims 1, 13 and 33-34**, Misra et al discloses a method for licensing software comprising:

- generating, on a local computer, a first install license for software installed on the local

computer (Col. 2, lines 62-67; Col. 3, lines 22-25; Table 1; Col. 11, lines 45-51; Col. 12, lines 8-14);

- obtaining, by the local computer in response to generating the install license, from a remote

computer a second license for software installed on the local computer, wherein the second license is

generated by the remote computer (Col. 2, lines 48-61; Col. 4, lines 54-59; Col. 8, lines 35-67; Col. 12,

lines 20-27; Col. 14, lines 8-14 and 49-53);

- determining, by the local computer, whether the second license is authentic (Col. 15, lines 29-

49), and

- replacing, if the second license is authentic, the install license with the second license (Col. 15,

lines 37-49; Col. 16, lines 49-67);

- selectively refreshing the second license prior to expiration of the second predetermined period

of time (Col. 14, lines 14-51; Col. 16, lines 49-67).

Misra et al discloses the generation of an install license on a license generator computer which is

the same license generator that generates the second license as well, however, fail to explicitly disclose

that a local computer generates the install license. Misra further fails to explicitly disclose that the second

license is a trial license. Gradient discloses a license delivery and installation tool the enables end users

to create software licenses of different types on their own system without outside intervention and further

teach that end users can create their own "try and buy" demo licenses for software and later, if the user

chooses to purchase an operational license, the desired license type may be selected from an options

menu and installed. Gradient teaches that authorized end users are able to instantly create short-term

licenses and allows end users, working at their own PC, to select from a variety of licensing options and

to create licenses of a variety of different types such as "try and buy" licenses that are installed within a

single user's workstation or PC. It would have been obvious to one of ordinary skill in the art at the time

of applicant's invention to modify the method of Misra et al and include the ability to allow a first computer

such as a end user to create their own license and store this license on the first computer wherein the

license is valid for an extended period of time such as an install license or for a predetermined short-term

period of time as taught by Gradient. Gradient provides motivation by indicating that this capability

revolutionizes the economics of software fulfillment and licensing and offers advanced tools that lower the

cost of license creation and delivery and further provides end users with complete control over their

software purchase and deployment decisions.

Misra further suggests the use of a temporary or trial license to replace an existing license (Col.

17, lines 7-35), however, fails to explicitly disclose that the second license is a trial license. Rose

discloses a system and method for managing try-and-buy usage of application programs and teaches the

installation of a trial version application along with the trial license for the application (Figure 9A-9B).

Rose further discloses later replacing the original trial license with another trial license (Col. 11, lines 3-

15) to enable continued use of the software. Examiner submits that the first trial license disclosed by

Rose is equivalent to the install license recited in the claims since applicant discloses in the specification that the "install" license is always set to expire immediately and only used to initiate the generation of a trial license (see applicant's specification, page 6, lines 19-25 and page 13, lines 6-13). Thus, the install license recited in the claims is essentially equivalent to a "trial license", such as that taught by Rose since the install license is only temporary and does not provide unlimited use of the software. Therefore, it would further have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Misra and replace the install license with a trial license as taught by Rose. Rose provides motivation by indicating that this would provide the user with an opportunity to continue to use the software under a trial version which would help the user to decide whether or not he/she desires to purchase the operational license (Col. 11, lines 5-12).

As per **Claims 2 and 25**, Misra et al further disclose

- setting, by the local computer, a first identifier to associate the install license with the local computer (Col. 9, lines 29-61; Col. 10, lines 51-59; Col. 12, lines 41-67);

- matching the unique identifier of the second license to the unique identifier of the install license, and if no matching occurs, discarding the second license without replacing the first license (Col. 11, lines 45-65; Col. 11 line 66-Col. 12 line 7; Col. 14, lines 30-39), and

- authenticating the digital signature of the second license, and if authentication fails, discarding the second license without replacing the install license (Col. 12, lines 8-15);

- replacing the install license with the second license if the second license is determined to be authentic (Col. 16, lines 39-67).

Misra does not specifically disclose that the second license is a trial license, however, this was discussed above with reference to claim 1.

As per **Claims 10 and 32**, Misra et al further disclose wherein the licenses are digitally signed (Col. 13, lines 42-63; Col. 14, lines 25-38).

As per **Claims 4 and 27**, Misra et al further disclose wherein obtaining from the remote computer the second license further comprises:

- connecting to the remote computer (Col. 14, lines 14-16)

- providing the remote computer with at least some of the data from the install license (Col. 14, lines 24-30)

- exchanging the provided data from the install license for the second license (Col. 14, lines 49-53; Col. 15, lines 11-18 and 37-49).

As per **Claims 5-6 and 28-29**, Misra et al further disclose wherein connecting to the remote computer comprises connecting to the remote computer via a communications network (Col. 4, lines 43-49).

As per **Claim 7,** Misra et al disclose all the limitations of claim 5, however, fail to specifically disclose wherein exchanging the install license for the second license includes formatting data from the install license according to a set of text processing rules and transmitting the formatted data using a text transfer protocol. Examiner takes Official Notice that formatting data according to a set of text processing rules such as HTML or XML and transmitting the formatted data using a text transfer protocol such as HTTP was well known in the art at the time of applicants invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use text processing rules such as HTML for formatting data and use a text transfer protocol such as HTTP for exchanging data since these formats and protocols were commonly used, especially in Internet communications since they were readily available and convenient to use.

As per **Claims 9 and 31**, Misra et al disclose verifying whether the replaced license is valid, including determining whether the replaced license has expired (Col. 14, lines 30-48).

As per **Claims 35 and 37**, Misra et al discloses a method for licensing software comprising:

- generating, on a local computer, a first install license in response to installing a software on the computer (Col. 2, lines 62-67; Col. 3, lines 22-25; Table 1; Col. 11, lines 45-51; Col. 12, lines 8-14);

- receiving , by the computer, a ping from an external software license servicing agent to detect the software install license (Figure 5; Col. 14, lines 1-29);

- generating a software temporary license in response to receiving the ping from the external software license servicing agent (Figure 5, Col. 14, lines 1-29 and Col. 17, lines 7-35).

Misra et al discloses the generation of an install license on a license generator computer which is the same license generator that generates the second license as well, however, fail to explicitly disclose that a local computer generates the install license. Misra further suggests the use of a temporary or trial license to replace an existing license (Col. 17, lines 7-35), however, fails to explicitly disclose that the second license is a trial license and that this license is generated by the local computer. Gradient discloses a license delivery and installation tool the enables end users to create software licenses of different types on their own system and further teach that end users can create their own "try and buy" demo licenses for software and later, if the user chooses to purchase an operational license, the desired license type may be selected from an options menu and installed. Gradient teaches that authorized end users are able to instantly create short-term licenses and allows end users, working at their own PC, to select from a variety of licensing options and to create licenses of a variety of different types such as "try and buy" licenses that are installed within a single user's workstation or PC. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Misra et al and include the ability to allow a first computer such as a end user to create their own license and store this license on the first computer wherein the license is valid for an extended period of time such as an install license or for a predetermined short-term period of time as taught by Gradient. Gradient provides motivation by indicating that this capability revolutionizes the economics of software fulfillment and licensing and offers advanced tools that lower the cost of license creation and delivery and further provides end users with complete control over their software purchase and deployment decisions.

Misra further suggests the use of a temporary or trial license to replace an existing license (Col. 17, lines 7-35), however, fails to explicitly disclose that the second license is a trial license. Rose discloses a system and method for managing try-and-buy usage of application programs and teaches the

installation of a trial version application along with the trial license for the application (Figure 9A-9B).

Rose further discloses later replacing the original trial license with another trial license (Col. 11, lines 3-

15) to enable continued use of the software. Examiner submits that the first trial license disclosed by

Rose is equivalent to the install license recited in the claims since applicant discloses in the specification

that the "install" license is always set to expire immediately and only used to initiate the generation of a

trial license (see applicant's specification, page 6, lines 19-25 and page 13, lines 6-13). Thus, the install

license recited in the claims is essentially equivalent to a "trial license", such as that taught by Rose since

the install license is only temporary and does not provide unlimited use of the software. Therefore, it

would further have been obvious to one of ordinary skill in the art at the time of applicant's invention to

modify the method of Misra and replace the install license with a trial license as taught by Rose. Rose

provides motivation by indicating that this would provide the user with an opportunity to continue to use

the software under a trial version which would help the user to decide whether or not he/she desires to

purchase the operational license (Col. 11, lines 5-12).

As per **Claim 36**, Misra et al further disclose storing the software install license as pong data (Col.

4, lines 64-67).

As per **Claim 38**, Misra et al further disclose receiving, by the computer, a purchased software

license from the external software licensing agent (Col. 4, lines 25-30; Col. 16, lines 38-67); and replacing

the first license with the purchased software license (Col. 16, lines 38-67).

6. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al, U.S. Patent

No. 6,189,146 B1 in view of Rose, U.S. Patent No. 5,708,709.

As per **Claims 39-41**, Misra et al disclose a method comprising:

- pinging, by a software license servicing agent, a computer to detect a software install license

(Figure 5; Col. 14, lines 1-29);

   - receiving, by a software license servicing agent, a software install license from the computer in

response to pinging the computer (Figure 5; Col. 14, lines 1-29);

   - generating, by the software license servicing agent, a second license in response to receiving

the software install license (Col. 2, lines 48-61; Col. 4, lines 54-59; Col. 8, lines 35-67; Col. 12, lines 20-

27; Col. 14, lines 8-14 and 49-53).

   Misra further suggests the use of a temporary or trial license to replace an existing license (Col.

17, lines 7-35), however, fails to explicitly disclose that the second license is a trial license. Rose

discloses a system and method for managing try-and-buy usage of application programs and teaches the

installation of a trial version application along with the trial license for the application (Figure 9A-9B).

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Rose is equivalent to the install license recited in the claims since applicant discloses in the specification

that the "install" license is always set to expire immediately and only used to initiate the generation of a

trial license (see applicant's specification, page 6, lines 19-25 and page 13, lines 6-13). Thus, the install

license recited in the claims is essentially equivalent to a "trial license", such as that taught by Rose since

the install license is only temporary and does not provide unlimited use of the software. Therefore, it

would further have been obvious to one of ordinary skill in the art at the time of applicant's invention to

modify the method of Misra and replace the install license with a trial license as taught by Rose. Rose

provides motivation by indicating that this would provide the user with an opportunity to continue to use

the software under a trial version which would help the user to decide whether or not he/she desires to

purchase the operational license (Col. 11, lines 5-12).

Conclusion

7.   The prior art previously made of record and not relied upon is considered pertinent to applicant's

disclosure.

- Horstmann discloses that an end user's machine is installed with a license certificate which typically is

installed during original installation of a software product and further including a relicensing manager

- Ross et al disclose a method and apparatus for electronic licensing in a network environment to facilitate product licensing and upgrades

- Coley et al disclose an automated system for management of licensed software and enabling or disabling the software accordingly

- Griswold discloses a license management system that periodically invokes a license check monitor to ensure valid usage of software and terminates use of the software is appropriate

- Horstmann discloses a method of relicensing of electronically purchased software

- Knutson discloses a method for licensing computer programs using DSA signature

- Carter et al disclose a method for network license authentication

- Cohen discloses a method for software licensing electronically distributed programs

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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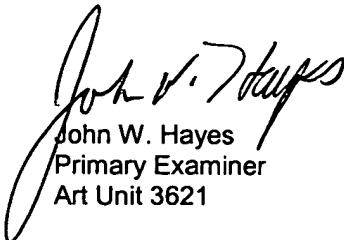
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                                  "Box AF"]

(703) 746-5531   [Informal/Draft communications, labeled
                                  "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

John W. Hayes
Primary Examiner
Art Unit 3621

January 26, 2005